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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,309	07/06/2001	Hidehiko Funaoka	010311	6699

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

16

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/806,309

Applicant(s)

FUNAOKA ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-10 and 27-29.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

NOTE

1. The After Final Amendment is not entered. It is noted that the cancellation of non-elected invention does not effect the prior rejection of claims 1-10 and 27-29, as set forth in section 2 of Paper No. 8, i.e., the prior rejection of the record is still deemed to be valid.
2. With respect to Takita's Declaration, the Examiner notes that it is generally untimely to submit Declaration after Final. As to the Declaration attesting that not only is the thermal setting necessary but also it is extremely important to timely conduct the thermal setting (Response, page 2, last paragraph), and the effect to the air permeability by a timely thermal setting is not recognized in each of US '633, US '183 and US 492, and the effect is unexpected (Response, page 3), the Examiner notes that the prior art combination encompasses and renders obvious the instant claimed invention. For example, the Examiner reiterates that the air permeability in Table I of Takita (US 5051183) is in the range of 30-148 sec/100cc, i.e., which has comparable or greater air permeability than the Applicants' membranes illustrated in Table A (see bottom paragraph on page 2, Paper No. 8). Additionally, it should be noted that the product-by-process limitation of "timely thermal setting" is not recited in the rejected claims; further, with respect to a product-by-process claim, Applicants must show that the resultant article is patentably distinct from those taught by the reference.
3. With respect to Applicants' argument that Examiner has not repeated an inherency argument in the Final Office Action (Response, pages 3-4, bridging

Art Unit: 1771

paragraph), the Examiner notes that the arguments set forth in the prior Office Action, i.e., Paper No. 6, are clearly repeated in section 2 of Paper No. 8 (specifically, see second paragraph on page 2).

4. With regard to Exhibit B of the Declaration, which shows that in US '183 the directivity of lamellas to the direction perpendicular to the membrane is lower than 40%, whereas the directivity of the instant claimed is at least 40%, Applicants' argument appears persuasive. If further prosecution, i.e., a CPA or RCE, is contemplated, the Examiner would like to strongly urge Applicants further clarify the unexpected directivity of lamellas and its relations to the "timely thermal setting", and also Applicants might further wish to clarify what "direction" constitutes the "mechanical direction" in claim 1.

5. Lastly, Applicants argue that "the air permeability is substantially independent of the pore diameter" is not persuasive (Response, pages 5-6). The Examiner notes that it is common knowledge that air permeability is dependent on both the pore size and the shape of the pores, clearly limitations to these parameters are required to determine the overriding parameter in a particular porous structure.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-

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Daniel Zinker